

RECEIVED  
CENTRAL FAX CENTER  
JUL 09 2008

Application No. 10/678,408

REMARKS

The Office Action of January 9, 2008 has been received and reviewed. This response, submitted along with a Petition for a Three-Month Extension of Time, is directed to that Action.

Claims 10-12 and 14 have been amended to correct their dependency, and claim 19 is new. Support for new claim 19 can be found throughout the specification, and particularly on page 22, lines 10-12. No new matter has been added.

The applicants respectfully request reconsideration in view of the foregoing amendments and the following remarks.

Claim Objections

The Examiner objected to claims 10-12 and 14 for depending upon a cancelled claim. These claims have been amended herein to correct the dependency, thus rendering this objection moot.

Claim Rejections- 35 U.S.C. §103

The Examiner rejected claims 1, 7, 10, 14, 15 and 18 under 35 U.S.C. §103(a) as obvious over CA 2,014,775 ("CA '775"); claims 1, 7, 10, 14, 15 and 18 as obvious over CA '775 in view of Karol (US 5,055,584) and Karol. (US 4,761,482); claims 1, 6-9 and 18 over CA '775 in view of Nakazato et al. (US 5,629,272); claims 1, 11 and 18 over CA '775 in view of Holt et al. (US 6,187,723) or Atherton (US 5,925,600); and claims 1, 12, 13 and 18 over CA '775 in view of

Application No. 10/678,408

Rowan et al. (US 4,889,647). The applicants respectfully traverse these rejections.

The Examiner stated that CA '775 teaches ester compounds prepared by reacting a C<sub>12</sub> to C<sub>22</sub> saturated or unsaturated fatty acid with monethanolamine or diethanolamine, and further with boric acid, resulting in a compound having a boron content in an amount of 1.1% by weight. Furthermore, according to the Examiner, CA '775 teaching mixing the boron compound with other additives such as derivatives of dimercaptodiadiazoles.

The applicants submit that the organo borate ester of the presently claimed invention differs from that of CA '775. The organo borate esters of the presently claimed invention is a mixture of both monoglyceride and diethanolamine fatty acid amide, whereas CA '775 teaches only a specific embodiment covering the diethanolamine fatty acid amide. The applicants submit that the mixture of monoglyceride and diethanolamine is taught in the present specification, particularly regarding the preparation of the borate ester composition (see page 22, lines 10-24). Therefore, CA '775 fails to teach the organo borate ester composition of the presently claimed invention, embodied particularly in new claim 19.

Moreover, the borate ester composition of the presently claimed invention is the specific organo borate ester compound used in the Examples in both the present specification and the applicant's 132 Declaration submitted on December 15, 2006.

In both the present specification and the Declaration, the data clearly shows that presently claimed invention exhibits unexpectedly superior results. A *prima facie* case of obviousness can be rebutted with a showing of new and unexpected results. When an organo borate ester additive is combined with any of the additives of component (2) in an amount according to the claimed

Application No. 10/678,408

ratio, an unexpected synergy is formed with respect to antiwear characteristics. High concentrations of borate ester alone (1% by mass or greater in relation to the lubricating composition as a whole) provide adequate antiwear protection, lower amounts of the same borate ester used alone lead to significantly inferior antiwear performance (Table A; Table 1, compare tests 1 and 10).

However, the present invention surprisingly discovered that acceptable antiwear results can be achieved even when using low amounts (<1% by mass) of borate ester if combined, according to the claimed ratio, with the additive of component (2). This synergy can be clearly seen in the data presented in the specification and previously filed declaration, and there is no teaching in the prior art references cited in the present Office Action that suggests that such a synergy is possible.

Accordingly, the applicants submit that the data in the present application supports the fact that the present invention shows unexpected and surprising results with respect to antiwear performance, which can be attributed to the synergy of the components when used according to the ratios of the present invention

The applicants further submit that none of Karol '584, Karol '482, Nakazato, Holt, Atherton, or Rowan remedy the deficiencies of CA '775 discussed hereinabove.

Based on the foregoing reasons, the applicants submit that a *prima facie* case of obviousness cannot be established, and respectfully request that the Examiner withdraw the present rejections. The applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully

RECEIVED  
CENTRAL FAX CENTER

JUL 09 2008

Application No. 10/678,408

requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263

Respectfully submitted,  
NORRIS McLAUGHLIN & MARCUS, P.A.

By



Mark D. Marin  
Reg. No. 50,842  
875 Third Avenue, 18<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 808-0700  
Fax: (212) 808-0844